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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,949

03/15/2004

Shinichi Shirahama

8305-239US (NP149-1)

4470

570

7590

04/03/2007

AKIN GUMP STRAUSS HAUER & FELD L.L.P.

ONE COMMERCE SQUARE

2005 MARKET STREET, SUITE 2200

PHILADELPHIA, PA 19103

EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/800,949

Applicant(s)

SHIRAHAMA ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 15 March 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### ***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants are required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Component (C) in claim 2 is a zinc secondary alkyldithiophosphate in an amount of 0.02 to 0.08 percent by mass in terms of phosphorus. However, the concentration is outside the scope of independent claim 1, from which claim 2 depends, since the amount of zinc secondary alkyldithiophosphate component (C) is in the range of 0.04 to 0.08 percent by mass in terms of phosphorus.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazato et al (6,569,818).

Nakazato et al ["Nakazato"] disclose a lubricating oil composition having a low phosphorus (P) content of 0.01 to 0.1 weight %, and a sulfated ash of 0.1 to 1 weight %, which is comprised of (a) a major amount of mineral base oil having a low sulfur (S) content of at most 0.1 weight %, (b) an ashless alkenyl or alkyl-succinimide dispersant or derivative thereof in an

amount of 0.01 to 0.3 weight % in terms of nitrogen atom content, (c) a metal-containing detergent such as an overbased alkaline earth metal salt of an alkylsalicylic acid in an amount of about 0.2 to 7 weight %, (d) a zinc dialkyl-dithiophosphate in an amount of 0.01 to 0.1 weight % in terms of a phosphorus content, and (e) an oxidation inhibitor. Nakazato teaches that the lubricating oil composition may be used in internal combustion engines such as diesel engines equipped with an exhaust gas after-treatment system. See column 2, line 25 to column 3, line 59. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the oil compositions such as the oxidation inhibitor component of the prior art. Nakazato teaches that the lubricating oil compositions may contain other auxiliary additives such as phosphoric acid esters, phosphorous acid esters and organic amide compounds such as oleylamide. Nakazato teaches that the additives can be incorporated into the lubricating oil compositions in an amount ranging from 0.001 to 3 weight %. See column 7, line 59 to column 8, line 11. Thus all of the components of applicants' claims are taught by Nakazato and the examiner is of the position that the claimed invention is clearly encompassed by Nakazato.

***Claim Rejections - 35 USC § 103***

Claims 1-5 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Yagishita et al (6,306,801) in combination with Nakazato et al (6,569,818).

Yagishita et al ["Yagishita"] disclose a lubricating oil composition suitable for use as a diesel engine oil which comprises a major amount of a lubricating base oil selected from mineral oils and synthetic oils and, as additives, (A) 0.5 to 20% by mass of acylated bissuccinimide, (B)

Art Unit: 1764

0.05 to 0.3 % by mass of zinc dithiophosphate in terms of the phosphorus content, and (C) 0.5 to 4.0 % by mass of metallic detergent in terms of the sulfated ash content, based on the total mass of the composition. See column 1, line 43 to column 2. Yagishita teaches that the metallic detergent component may be an overbased alkaline earth metal salicylate having a total base number of 100 to 450 mgKOH/g. See column 9. Applicants' invention differs by adding a phosphorus-containing ashless antiwear agent and, in dependent claim 2, by adding a fatty acid amide to the lubricating oil compositions. However, Yagishita allows for the addition of known additives to the compositions including antiwear agents. As set forth above, Nakazato teaches that the lubricating oil compositions, which are suitable for use as diesel engine oils, may contain other auxiliary additives such as phosphoric acid esters, phosphorous acid esters and organic amide compounds, such as oleylamide, in amounts ranging from 0.001 to 3 weight %. The examiner is of the position that it would have been obvious to the skilled lubricating oil formulator to have added any conventional engine oil additive to the lubricating oil compositions of Yagishita if the known imparted properties were so desired.

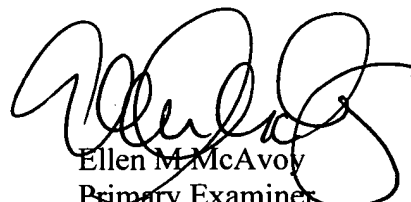
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
March 27, 2007